



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,505	05/29/2001	Donald R. Katz	2541P001CD2	5909

8791 7590 12/17/2004

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

DINH, DUNG C

ART UNIT	PAPER NUMBER
----------	--------------

2152

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,505

Applicant(s)

KATZ ET AL.

Examiner

Dung Dinh

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-144 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-144 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 9/13/04 have been fully considered but they are not persuasive.

Regarding claims 132-136 and 138-144, Applicant argued that the target logic is external to the player. The argument is not persuasive because the claim does not recite such limitation. As per the limitation of downloading the header to the player, the claims do not specifically require transmitting the target header directly from the network to the player. Therefore transferring from the ROM to the player is enough to constitute downloading as claimed. Muyan disclosure on col.14 lines 52-65 is ambiguous as who is actually doing the coding of the ROM 360 content. However, Muyan clearly states that the player ID and the user ID are transmitted to the bookstore for verification and the bookstore will terminate the connection if they are invalid [col.14 lines 54-56, 62-65]. Since, the bookstore receives the player ID and user ID upon establishing a connection, a reasonable inference can be made that the bookstore is the one doing the coding so the content is uniquely associate with the player so as to prevent the content downloaded and stored in ROM 360 from being used on another player.

Art Unit: 2152

As per claim 39-53 and 55-131, applicant argued that there is no motivation to combine. Myan teaches the bookstore (i.e library server) receive and authenticate the player ID and user ID upon connection [apparent from col.14 lines 52-56, 63-65] prior to permitting the user to download content. Hence, Myan bookstore has data correlating the player ID to the content being downloaded. As per the encoding of the content specifically to player, the suggestion for doing so is there as point out above.

This is a non-final rejection to correct the statutory ground of rejection for claims 137 and 139-144 to 35 USC 103(a).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2152

Claim 132-136, 138 are rejected under 35 U.S.C. 102(e) as being anticipated by Munyan US patent 5,761,485.

As per claim 132, Munyan teaches a computer based library system comprising:

a computer system [fig.1 #10] connectable to a network, the computer system comprising targeting logic for generating targeted header containing information indicative of a player ID corresponding to a particular player for rendering content, and downloading logic for downloading the targeted header with associated content to a player [col.9 lines 29-54, col.14 lines 52-64].

As per claim 133, Muyan teaches the ID correlate to a particular user [col.14 line 52-55 user identification code].

As per claim 134, Muyan teaches the ID correlate to a particular player device [col.14 line 52-55 security identification code].

As per claims 135-136, Muyan teaches the device being a mobile device with wireless connection (see fig.1)

As per claim 138, Muyan teaches to encrypt the content hence it is inherent that Muyan has a key to decrypt the content.

Art Unit: 2152

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 137, 139-144 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan US patent 5,761,485 and further in view of Ferrel et al. US patent 6,230,173.

As per claim 137, Munyan does not teach providing mapping of the associated content. In similar field of invention, Ferret teaches map for associated content (see fig.14, col.24 lines 35-54). It would have been obvious for one of ordinary skill in the art to combine the teaching of Ferret to Munyan because it would have enable providing multiple contents to the player.

As per claim 139, they are rejected under similar rationale as for claims 132 + 137 above.

As per claim 140, Muyan teaches the ID correlate to a particular user [col.14 line 52-55 user identification code].

Art Unit: 2152

As per claim 141, Muyan teaches the ID correlate to a particular player device [col.14 line 52-55 security identification code].

As per claims 142-143, Muyan teaches the device being a mobile device with wireless connection (see fig.1)

As per claim 144, Muyan teaches to encrypt the content hence it is inherent that Muyan system as modified has a key to decrypt the associated content.

Claims 39-53, and 55-131, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrel et al. US patent 6,230,173 and further in view of Munyan US patent 5,761,485.

As per claim 39, Ferrel an system for generating and maintain a plurality of digital information files for delivery over a public network, the system comprising:

an authoring system for receiving raw digital data and transforming said raw digitized data into the digital information files (col.6 lines 25-30, col.20 to col.24); and generating information indicative of various characteristics of content of said digital information files (col.21 lines 49-54); and

a library server coupled to the authoring system including logic for maintaining the digital information files (col.6 lines

Art Unit: 2152

46-62). Ferrel does not teach maintaining correspondence to player ID information, encrypting the digital information files using the player ID information, and authorizing access to a user having a corresponding player ID.

In similar field of electronic publishing, Munyan teaches to encode contents with each user's unique player ID (key) so that each user can only read files made for them; therefore discourage incentive to pirate copying of the files (Munyan col.14 lines 52-65).

Hence, one of ordinary skill in the art would have been motivated to combine the teaching of Munyan with Ferrel to have the library server maintain correspondence between digital file and player ID and to encrypt the files using the player ID because it would have improved the security library system and reduces pirating of the digital information files.

As per claim 40, Ferrel teaches providing various multimedia files. It is apparent the Ferrel system would have audio, image, text, video, etc. The type of files provided would have been clearly a matter of design choice. It would have been obvious for one of ordinary skill in the art to includes any of the various type files recited as appropriate to a publication project.

As per claims 41, Ferrel as modified has means for segmenting the digital information files (Ferrel fig.10), scrambling

Art Unit: 2152

(encoding the file). The references do not specifically disclose compressing. However, it would have been obvious for one of ordinary skill in the art to compress the files because it would have save storage space and transmission bandwidth.

As per claim 42, it is would have been obvious for one of ordinary skill in the art in the system as modified to have a descrambling map so as to enable the receiving system to decode the files.

As per claim 43, Ferrel teaches incorporating characteristic information with the content (col.22 lines 35-64).

As per claim 44, it is apparent that Ferrel system as modified would have mean to manage and responsive to user request for delivery of the encoded digital information files in order to deliver files encoded corresponding the requesting user's player ID.

As per claim 45, Ferrel teaches to personalize and to provide billing for services (col.6 lines 9-11). Hence, it would have been obvious for one of ordinary skill in the art to collect and store statistics of access history so as to enable billing and customization to the users' habit.

As per claim 46, the references do not specifically disclose an authentication server. Munyan discloses checking the validity of the user and security identification. Hence, it is apparent

Art Unit: 2152

that Munyan would have had an authentication server to perform this function. Furthermore, the use of an authentication server is well known in the art for regulating access to content over a network. It would have been obvious for one of ordinary skill in the art to provide an authentication server because it would have enabled the system to regulate access the contents and improved the security of the system.

As per claim 47, Ferrel teaches running the library server on several computer (col.12 lines 51-60).

As per claims 48-49, it is apparent that Ferrel system as modified would have the authoring (publishing), library server (application server) and the authentication sever software running on different computers. It would have been obvious for one of ordinary skill in the have them run on different computers because it would have prevent a single point of failure and enable the functions to be distributed at various point on the network.

As per claim 50, it is apparent that the Ferrel system as modified would 'target' the files using the player ID so as to uniquely encode the file for the targeted user.

As per claims 51-52, point-to-point authentication and digital signature authentication are well known security methods. The usage of either or both methods would have been a matter of design choice. It would have been obvious for one of ordinary

Art Unit: 2152

skill in the art to use any number of known authentication methods, including point-to-point and digital signature, because the implementations are well-known and program logic for implement them are readily available.

As per claims 53, they are rejected under similar rationale as for claim 39 above.

As per claim 55, Ferrel teaches including files which are primarily textual content (col.23 lines 24-33).

As per claims 56-58, 59-71, 72-85, 86-99 they are rejected under similar rationale as for claims 39-52 above. Regarding claims 76-79, and 90-93, the types of ID recited to encode the contents are clearly obvious variation from the teaching of Munyan. It would have been obvious for one of ordinary skill in the art to use any type of ID that can uniquely identify a set of users or devices so long as it can prevent playback on unauthorized device.

As per claims 110-120, they are rejected under similar rationale as for claim 39-52 above. Munyan teaches using a wireless client device for downloading and viewing the content (see Munyan fig.1). Regarding claims 115-118, the types of ID recited to encode the contents are clearly obvious variation from the teaching of Munyan. It would have been obvious for one of

Art Unit: 2152

ordinary skill in the art to use any type of ID that can uniquely identify a set of users or devices so long as it can prevent playback on unauthorized device.

As per claims 100-105, and 121-124, the various types of networks: wired, wireless, IR, telephone, etc. are well known in the art. The type of communication medium used would clearly have been a matter of design choice because the library system would operate essentially the same way regardless of the type of connection use.

As per claims 107-109, and 126-127, Ferrel teaches local library for local storage of programming content (col.12 lines 55-59).

As per claim 125, Munyan teaches using removable memory (col.14 lines 19-32).

As per claim 128-129, it would have been obvious for one ordinary skill in the art to have descrambling logic and decompression logic in the player device in order to the player to decode the contents for playback.

As per claims 130-131, Ferrel teaches providing characteristic of the file so that contents can be search for. Hence, it would have been obvious for one of ordinary skill in the art to provider the playback device with capability to browse the

Art Unit: 2152

characteristic so as to enable the user to locate and request the desired contents.

Claims 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrel et al. US patent 6,230,173 and further in view of Munyan US patent 5,761,485 and Fernandez US patent 4,855,725.

As per claim 54, Ferrel an system for generating and maintain a plurality of digital information files for delivery over a public network, the system comprising:

a library server coupled to the authoring system including logic for maintaining the digital information files (col.6 lines 46-62). Ferrel does not teach maintaining correspondence to player ID information, encrypting the digital information files using the player ID information, and authorizing access to a user having a corresponding player ID and creating a CDROM.

In similar field of electronic publishing, Munyan teaches to encode contents with each user's unique player ID (key) so that each user can only read files made for them. This eliminates the motivation to pirate copies of the file (see Munyan col.14 lines 52-64).

Art Unit: 2152

Also in the field of electronic publishing, Fernadez teaches providing content on a CDROM such that the user can download to and read on a portable device at the user leisure (see abstract).

Hence, one of ordinary skill in the art would have been motivated to combine the teaching of Munyan with Ferrel to have the library server maintain correspondence between digital file and player ID and to encrypt the files using the player ID because it would have improved the security library system and reduces pirating of the digital information files.

It would have been obvious for one of ordinary skill in the art to provide contents on a CDROM because it would have enabled the user to quickly access to certain information without having to download it from the library server.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (571) 272-3943. The examiner can normally be reached on Monday-Thursday from 7:00 AM - 4:30 PM. The examiner can also be reached on alternate Friday.

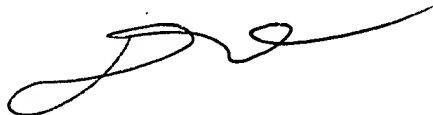
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached at (571) 272-3949.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

Art Unit: 2152

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Dung Dinh', with a stylized, flowing script.

Dung Dinh
Primary Examiner
December 8, 2004